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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,154	10/21/1999	CLOIS E. POWELL	303/1/151	5181

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 09/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/422,154

Applicant(s)

POWELL ET AL.

Examiner

Katarzyna W. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-13,15-20,31-33,35-41 and 45 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1,4-13,15-20,31-33,35-41 and 45 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The specification filed on May 13, 2002 will not be entered according to MPEP 714.20 for the following reasons:

- 1) The applicant has not provided a statement in the amendment stating that no new matter is introduced.
- 2) New specification has countless new matter issues some of which are depicted below in paragraph 1.

1. The amendment filed May 13, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure is as follows:

Newly submitted specification contains numerous new matter issues on almost every page of the specification. Examples include applicant's broader specification, which would include species not previously encompassed by the disclosure. Another example is changing the amounts components used in the specification to amounts that can be used. Change of "transfer rate greater than" to "maybe greater", another change is from "must" to "may in many circumstances" or "this is because" to "it is believed" or from "hydrogenated tallow" to "tallow",

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which chemically is a different compound or from “relatively inadequate” to “less efficient” where something that was previously inadequate may now be used. These are just few of the numerous new matter issues.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-111 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Present claims are now viewed in the light of specification, which contains new matter. This results in claims containing new matter as well. Claims are therefore rejected.

Claims 48, 59 reciting fatty acids having C<sub>12</sub>-C<sub>23</sub> carbon atoms are rejected as a new matter, since the specification only enables one of ordinary skill in the art to utilize fatty acids having C<sub>12</sub>-C<sub>22</sub> carbon atoms.

Claims 50-51 reciting C<sub>16</sub>-C<sub>22</sub> fatty acids are rejected as new matter, since again the specification enables one to utilize fatty acids having C<sub>12</sub>-C<sub>22</sub> carbon atoms. In order to recite

C<sub>16</sub> the applicant has to have an explicit recitation of such compound in the specification. Also the particular fatty acids having iodine value as stated in claims 50-51 also need support in the specification.

All the claims 55, 80 reciting fatty acid to ether alkanol amine ratio of 1.65-1.75 and 1.68-1.72 are viewed as new matter since these are the ratios of fatty acid to alkanol amine. Ether alkanol amine and alkanol amine are related but they are not the same.

Claim 55 further has no support in the specification therefore the entire claim is rejected as containing new matter.

Claims 59 and 84 contain figure, which differs from that in the specification by not having a charge on the nitrogen atom. It is therefore neutral species not an ammonium compound taught by the present invention. Claims also teach amount of the carbon atoms other than 12 and 22 as taught by the spec.

Claims 60-62, 85-87, 89, 90 also have no support in the specification for the lower amount of the carbon atoms and since they are added claims specific recitation of that particular number has to be reflected in the specification.

Claims 65, 75, 76 also disclose numerical range for carbon atoms not taught by the spec as well as iodine value for that particular species.

Claim 73 teaches compounds having 12-23 carbon atoms, wherein 23 is not supported by the spec.

Claims 58, 59, 83, 84 are further rejected for its recitation of sulfate. The specification teaches use of only 2 sulfates, mainly of CH<sub>3</sub>SO<sub>4</sub> and C<sub>2</sub>H<sub>5</sub>SO<sub>4</sub>. Use of term sulfate in these newly added claims reads on additional sulfates not specified in the present invention.

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 48-111 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 48, 50, 51, 58-62, 64, 65, 73, 75-76, 83-87, 89-90 use of term “substituted” renders claim indefinite, since the specification does not reasonably define what the substituents exactly are.

Claims 57, 82 are rendered as indefinite claims since it contains an improper Markush language. According to MPEP 2173.05(h) the Markush language may recite for example: “...wherein R is selected from the group consisting of A, B, C and D” or “...wherein R is A, B, C or D”.

Updated search resulted in 3 additional references of Beal (US 6,287,634 B1), Ross (US 6,380,295 B1) and Qian (US 6,407,155 B1), which although recite esters as the intercalating agents, they do not teach overall claims of the present invention. Therefore, there is no art rejection against present claims. However, the application cannot be allowed at this point due to

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presence of new matter in the specification and numerous 112 rejection both 1<sup>st</sup> and 2<sup>nd</sup> paragraphs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna W. Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

KIWL  
September 5, 2002

EDWARD J. CAIN  
PRIMARY EXAMINER  
GROUP 1500

